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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/074,586 | 02/12/2002 | Jerry Kupsh | 3356/OKO43 | 5372 |
| 7278 | 7590 | 10/03/2005 | EXAMINER | |
| DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257 | | | PEREZ, JULIO R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2681 | |

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,586

Applicant(s)

KUPSH ET AL.

Examiner

Julio R. Perez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/01/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claims 1-13, 15 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 5-8,10,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnanen [6085100] in view of Donovan et al. (hereinafter Donovan) [6519468].

Regarding claim 1, Tarnanen discloses a method for tracking messages delivered via a short message service (SMS) comprising the steps of: receiving, at a gateway, a message destined for a mobile device (col. 3, lines 1-14; col. 5, lines 9-21; col. 6, lines 24-27, a message is sent to a mobile device from an external source and arrives at a gateway database before being forwarded to the mobile station); assigning a unique identifier to the received message (col. 2, lines 32-46; col. 3, lines 1-14; col. 5, lines 9-21; col. 5, lines 9-21; col. 6, lines 24-37, an identifier is formed for the sent message); recording the unique identifier in a database accessible to the gateway (col. 2, lines 38-46; col. 3, lines 1-14; col. 5, lines 4-26; col. 6, lines 20-37; Figs. 2, 4, the information about the message and its identifier are stored in a database within the

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gateway application); and forwarding the received message from the gateway to the mobile device, wherein the forwarded message sent from the gateway to the mobile device includes an origination address, the origination address being derived from the unique identifier (col. 2, lines 55-67; col. 5, lines 28-67; col. 6, lines 1-37, the message delivered to the mobile station including the origination address corresponding to the address that transmitted the message).

Tarnanen, however, fails to explicitly disclose allowing either a sender or a recipient of the message to log on to the gateway to access and view the message recorded in the gateway.

In a similar field of endeavor, Donovan discloses a subscriber terminal for use in a communications system with short message capabilities that includes the ability to let the subscriber access the short message center to access the short message stored in its database for reviewing (col. 5, lines 35-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tarnanen with the teachings of Donovan for the purpose of providing means to review the messages stored in the database at the gateway in order to provide a convenient and resourceful mechanism-based system that produces friendly usage and accessibility to subscribers.

Regarding claim 2, the combination of Tarnanen and Donovan discloses, the step of sending the message to a short message service center (Tarnanen, col. 5, lines 12-14; Fig. 2, ref. 2, the message is passed via an SMSC).

Regarding claim 5, the combination of Tarnanen and Donovan discloses, wherein the origination address of the message sent from the gateway to the mobile device includes the unique identifier (Tarnanen, col. 2, lines 32-37; col. 3, lines 1-14; col. 5, lines 9-21; col. 5, lines 9-21; col. 6, lines 24-37, an identifier is formed to identify the short message, including the origination address of the message sent).

Regarding claim 6, the combination of Tarnanen and Donovan discloses, the method, including the further steps of: receiving, at the gateway, a reply to the message from the mobile device (Tarnanen, col. 2, lines 55-67, a reply is passed to the gateway application); correlating the reply to the sent message by means of the unique identifier (Tarnanen, col. 2, lines 55-67; col. 3, lines 1-14; col. 5, lines 64-67; col. 6, lines 1-19, the gateway retrieves the original source address of the message to transmit a corresponding reply); and recording the correlated reply in the database storing the sent message (Tarnanen, col. 3, lines 1-14; Fig. 2, refs. 3,4, a record of the response is stored in a database).

Regarding claim 7, the combination of Tarnanen and Donovan discloses, wherein the destination address of the reply sent to the gateway is the origination address of the forwarded message (Tarnanen, col. 5, lines 57-67; col. 6, lines 1-19, the reply will be sent to the address, corresponding to the originating message).

Regarding claim 8, the combination of Tarnanen and Donovan discloses, including the further step of allowing either of the sender or the recipient to access and view the reply recorded in the reply recorded in the database (Donovan, col. 5, lines 35-46).

Regarding claim 10, Tarnanen discloses a system for recording message sent from a first communication device connected to a first network to a second communication device connected to a second network, the system comprising: a database and a gateway, the database connected to the gateway and the gateway connected to the first and second network (col. 5, lines 9-46; Fig. 2, refs. 2-3, the system includes first and second networks, a gateway application, and data base; furthermore, it is inherent as evidenced by the fact that one of ordinary skill in the art would have recognized that gateways comprise means to administer data or information within, therefore, comprising means to monitor and process data), the gateway including a microprocessor which is programmed to: receive each of the plurality of messages from the first communication device destined for the second communication device (col. 3, lines 1-4; col. 5, lines 9-27; col. 6, lines 24-27, a message is sent to a mobile device from external sources, located on a different network, through the gateway), assign a unique identifier to the message (col. 2, lines 32-37; col. 3, lines 1-14; col. 5, lines 9-21; col. 5, lines 9-21; col. 6, lines 24-37, an identifier is formed for the sent message), and forward the message to the second communication device connected to the second network, wherein the origination address of the forwarded message is derived from the unique identifier (col. 2, lines 55-67; col. 5, lines 64-67; col. 6, lines 1-37, the message delivered to the mobile station including the origination address corresponding to the address that transmitted the message).

Tarnanen, however, fails to explicitly disclose allowing either a sender of the first communication device log on to the gateway to access and view the message recorded in the gateway.

In a similar field of endeavor, Donovan discloses a subscriber terminal for use in a communications system with short message capabilities that includes the ability to let the subscriber access the short message center to access the short message stored in its database for reviewing (col. 5, lines 35-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tarnanen with the teachings of Donovan for the purpose of providing means to review the messages stored in the database at the gateway in order to provide a convenient and resourceful mechanism-based system that produces friendly usage and accessibility to subscribers.

Regarding claim 15, the combination of Tarnanen and Donovan discloses the system, wherein the second network is a short message service (SMS) network and the gateway is connected to a short message service center (Tarnanen, col. 5, lines 12-14; Fig. 2, ref. 2, 3, the message is passed via an SMSC, where the SMSC is connected to the Gateway application).

4. Claims 3,4, 9, 11-13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarnanen [6085100] in view of Donovan et al. (hereinafter Donovan) [6519468] and further in view of Moran et al. (hereinafter Moran) [20020086689].

Regarding claim 3, the combination of Tarnanen and Donovan does not explicitly disclose wherein the sender of the message received at the gateway communicates with the gateway via the Internet.

Moran, however, discloses a method for routing wireless messages using the Internet via a rerouting Gateway (Page 2, par. 0026; Fig. 2, ref. 76).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the system as taught by Tarnanen and Donovan to implement the system with Internet routing means because it would provide the system with other alternatives of routing messages to selected destination devices efficiently and securely.

Regarding claim 4, the combination of Tarnanen, Donovan, and Moran discloses the method, wherein the gateway is an Internet Gateway identified by a domain name, the domain name being included in the origination address of the message sent from the gateway to the mobile device (Moran, Page 2, pars. 0026-0027; 0031-0032).

Regarding claim 9, the combination of Tarnanen, Donovan, and Moran discloses the method, wherein the message and reply are accessed using a web browser (Moran, Page 2, pars. 0026-0027; 0031-0032; Fig. 2).

Regarding claim 11, the combination of Tarnanen, Donovan, and Moran discloses, wherein the first network is the Internet and the second network is the short message service network (Moran, Page 2, pars. 0026-0027; 0031-0032; Fig. 2, refs. 76; 16, 28, 40, 50).

Regarding claim 12, the combination of Tarnanen, Donovan, and Moran discloses, the system, wherein the first communication device is a personal computer and the second communication device is a mobile device (Moran, Page 2, pars. 0026-0027; 0031-0032; Fig. 2, refs. 72-74; 84-90, the system comprises a computer as a sender and mobile phones as receivers).

Regarding claim 13, the combination of Tarnanen, Donovan, and Moran discloses the system, wherein the first communication device communicates with the gateway via the Internet using a web browser (Moran, page 2, pars. 0026-0027; 0031-0032; Fig. 3, refs. 76, 94, 100, the system includes wireless terminals that connect to the Internet and able to retrieve information from a database collocated within the rerouting gateway), the gateway further programmed to allow the user to access and view a reply recorded in the database (Donovan, col. 5, lines 35-46).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pat. No. 6,078,820 to Wells et al.

Real time SMS applications

Pub. No. 2050185634 to Benco et al.

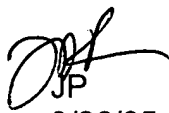
Messaging between SMS IM
subscribers

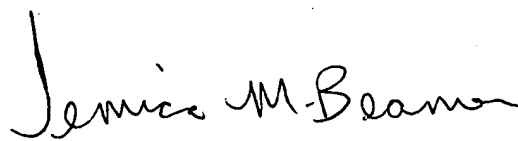
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio R. Perez whose telephone number is (571) 272-7846. The examiner can normally be reached on 7:00 - 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272- 4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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